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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,450	08/06/2002	Assaf Dekel	110/01309	6918

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EXAMINER

DAVIS, DANIEL J

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,450

Applicant(s)

DEKEL, ASSAF

Examiner

D. Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 29-31,33-36 and 57-60 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56 is/are allowed.
- 6) ☒ Claim(s) 1-28,32,37-50 and 52-55 is/are rejected.
- 7) ☒ Claim(s) 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/22/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show how the elbows 204 are attached to the device. (Applicant may argue that the elbows are not attached.) Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,725,530 to Popken. Popken discloses a handle 17 (figure 2), first and second extensions 84 (figure 3), and a flexible rasp 22.

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over ***** which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27, 32, 37, 39, 40-42, 44-50 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,372,553 to Coddington. Coddington discloses an apparatus for removing bone comprising a handle 14, first and second extensions 13 and a flexible rasp. The outer surfaces of the extensions contacting the rasp 10 comprise the first and second tips. The central portions of the extensions 13 comprise the pick reel/rasp advancer. The device comprises a shield 15. Alternatively, the shield may comprise the smooth backing 10 as illustrated in figure 4. The shield of the smooth backing and the rasp are fully capable of being removed, inverted, and replaced to change the "relative positions." The central portion of the extensions 13 comprises a resting point. The water X is a source of cleaning fluid. The reels are two separate parts during normal use. An end of the band constitutes a "leader." The device comprises a rasp advancer including the axel of the reel.

Coddington fails to disclose that the flexible rasp is "adapted for passage through a spinal channel of a live human" since the rasp appears to be one monolithic loop, which cannot be placed within the vertebral channel of a live human. Nevertheless, It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the band separable (and reattachable) since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. A separable flexible file may be passed through vertebrae.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the band separable (and reattachable) enabling a user to easily remove and replace the band from the reels.

Regarding claims 15-19, 40 and 41, Coddington fails to disclose that the width of the rasp is less than 2 mm. Nevertheless, it has been held that mere changes in size are within the level of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rasp width less than 2 mm.

The length of the rasp is not specified. Nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rasp between 1 and 3 meters or any length as needed.

Respecting claims 20-23, Coddington fails to disclose the thickness of the rasp. Nevertheless, the patent discloses in column 1, lines 13-17 the desirability to make the thickness small. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the thickness less than .1 mm to increase flexure and extend the cutting life.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popken. Popken discloses the claimed invention except for Describe difference and press the rasp being bioabsorbable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the rasp out of a bioabsorbable material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coddington in view of U.S. Patent No. 2,355,124 to Testo. Coddington fails to disclose that the active length

is adjustable. Nevertheless, Testo discloses an adjustable active length to change the size according to the particular needs of a user.

Coddington is silent regarding the exact size of the active length. However, the reference compares the device to a band saw (column 1, lines 1-7), giving the impression that it might be about the size of a small abdomen. Nevertheless, it has been held that mere changes in size are within the level of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the active length to span between two and ten adult vertebra.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coddington in view of U.S. Patent No. 5,713,785 to Nishio. Coddington fails to disclose a vacuum source. Nishio teaches a vacuum source for “exhausting dust emitted during the sanding” (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a vacuum source as taught by Nishio in order to capture airborne particles.

Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coddington in view of U.S. Patent No. 3,523,345 to Nilsson. Coddington fails to disclose a spring and to maintain tension. Nevertheless, Nilsson teaches a spring (F) and gauge (G) to tension and measure the tension of the abrader. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Coddington device as taught by Nilsson to include a spring and gauge to maintain a measured amount of tension in the Coddington device when in use.

Allowable Subject Matter

Claim 56 is allowed.

Claim 51 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed November 23, 2005 have been fully considered. The objection to the drawings under 37 CFR 1.83(a), as not showing the "means for affixing" as recited in claim 51 is withdrawn. The rejection of claim 28 under 35 U.S.C. 112, first paragraph is withdrawn.

Applicant traverses the rejection of claim 1 as being unpatentable over Coddington. Applicant states that it is known to include a mechanism for moving the wheels closer to remove the rasp. Coddington, however, does not disclose such a mechanism. Applicant also traverses on the grounds that "splitting" or apparently "fracturing" the metal would reduce the life of the device. Examiner does not state that the process of making the metal band includes "fracturing," as applicant apparently contends. Examiner asserts that it is obvious to make the band separable. The means for attaching and reattaching is entirely unknown and not important to the question of obviousness.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD


EDUARDO C. ROBERT
PRIMARY EXAMINER